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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,920	12/12/2003	Michael Muller	IBM-001	2237
51835 7590 07/26/2007 IBM LOTUS & RATIONAL SW c/o GUERIN & RODRIGUEZ 5 MOUNT ROYAL AVENUE MOUNT ROYAL OFFICE PARK MARLBOROUGH, MA 01752				
			EXAMINER JOO, JOSHUA	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,920

Applicant(s)

MULLER ET AL.

Examiner

Joshua Joo

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/5/04, 5/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. Claims 1-32 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted 5/05/2004 and 5/10/2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 23-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 23, Applicant is seeking to patent a computer program product for use with a computer system, the computer program product comprising a computer useable medium having embodied therein program code. The computer program product does not comprise any hardware and does not store data. The computer program product embodies program code, which may be interpreted as software or signal per se, i.e. signal or software embodying code. The claimed invention of the computer program product does not meet one of the four categories of invention and is not statutory. Specifically, computer program product is not a series of steps or acts and thus is not a process. Computer program product is not a physical article or object and as such is not a machine or manufacture. Computer program product is not a combination of substances and therefore not a composition of matter.

Regarding claim 28, Applicant is seeking to patent a computer data signal embodied in a carrier wave. The claimed invention of a computer data signal embodied in a carrier wave does not meet one of

Art Unit: 2154

the four categories of invention and is not statutory. Specifically, computer data signal embodied in a carrier wave is not a series of steps or acts and thus is not a process. Computer data signal embodied in a carrier wave is not a physical article or object and as such is not a machine or manufacture. Computer data signal embodied in a carrier wave is not a combination of substances and therefore not a composition of matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 10, 18-19, 23-24, 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kalfas, US Publication #2004/0199598 (Kalfas hereinafter).

7. As per claim 1, Kalfas teaches the invention as claimed including a method of communicating with a user of a processor-based device over a network, the method comprising:

providing a body-less electronic mail message having a subject line (Paragraphs 0032; 0034.

Subject field. Examiner considers the term “body-less” as content only in the header of the message.);

receiving a text message into the subject line of the body-less electronic mail message (Paragraph 0034. Complete message in the subject field.); and

transmitting the body-less electronic mail message to the user over the network (Paragraph 0032.

Header field utilized for routing message to recipient. Paragraph 0038. The complete message in the subject field in inbox of user.).

8. As per claim 10, Kalfas teaches the invention as claimed including a computing system, comprising:

a display screen; an input device; a network interface (Paragraphs 0043; 0057. User composes email and sends email. Display screen, input device, and network interface are inherent.); and

a processor running an electronic mail program to present to a user on the display screen a body-less electronic mail message having a subject line (Paragraphs 0032; 0034. Subject field. Examiner considers the term "body-less" as content only in the header of the message. Processor is inherent to use email program.), wherein the user operates the input device to enter a text message into the subject line of the body-less electronic mail message (Paragraph 0034. Complete message in the subject field.), and the network interface transmit the body-less electronic mail message having the text message in the subject line over a network (Paragraph 0032. Header field utilized for routing message to recipient. Paragraphs 0038. The complete message in the subject field in inbox of user.).

9. As per claims 18, 23, and 28, Kalfas teaches the invention as claimed including an apparatus and computer program product for communicating with a user of a processor-based device over a network, the apparatus comprising:

means for providing a body-less electronic mail message having a header (Paragraphs 0032-0033. Header. Examiner considers the term "body-less" as content only in the header of the message.);

means for recording a temporal sequence of one or more text messages into the header of the body-less electronic mail message (Paragraph 0034. Complete message in the subject field); and

means for transmitting the body-less electronic mail message to the user over the network (Paragraph 0032. Header field utilized for routing message to recipient. Paragraphs 0038. The complete message in the subject field in inbox of user.).

10. As per claims 19, 24, and 29, Kalfas teaches the apparatus of claim 18, further comprising means for displaying the body-less electronic mail message as a line item in a mailbox view and for displaying the entire temporal sequence of one or more text messages while in the mailbox view (Paragraphs 0037-0038. List of emails. Message is displayed in subject column. No need to open message.).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalfas, in view of obviousness.

13. As per claims 2 and 11, Kalfas does not specifically teach the method of claim 1, wherein the subject line of the body-less electronic mail message includes one or more other text messages taken from a subject line of a previous body-less electronic mail message.

However, it would have been obvious to one of ordinary skill in the art that a user may retype the text of a previous subject in the subject line, i.e. text of a previously received message, and send the message, which would result in the subject line having the text of the previous message and indicate the subject matter to a receiving user. Furthermore, it is well known in the art that responding to message may be result in the text "re:" followed by previous subject matter.

Art Unit: 2154

14. As per claim 6, Kalfas does not specifically teach the method of claim 1, further comprising inserting a delimiter into the subject line to separate the text message from a previous text message currently included in the subject line.

However, Kalfas taught of typing a message into the subject, and it would have been obvious to one of ordinary skill in the art that a user may type a symbol such as “:”, “/”, other types of characters or symbols to separate and organize texts in a message including texts from a previous message.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kalfas, in view of Szeto et al. US Publication #2004/0215721 (Szeto hereinafter) and Rukman, US Publication #2004/0185883 (Rukman hereinafter).

16. As per claim 3, Kalfas does not specifically teach the method of claim 1, wherein the subject line of the body-less electronic message includes one or more other text messages taken from a chat conversation converted into a format of a body-less electronic mail message.

Szeto teaches of converting an instant message into an e-mail message (Paragraph 0036).

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the teachings of Kalfas with the teachings of Szeto to convert an instant message into the email message such as the format of the message in Kalfas. The motivation for the suggested modification is that Szeto's teachings would allow instant messaging between an email user and instant messaging user (abstract).

18. Kalfas and Szeto still do not specifically teach that the subject line of the body-less electronic message includes one or more other text messages taken from the chat conversation.

Art Unit: 2154

Rukman teaches of converting a SMS message into a MMS message, which can be used to send an email, wherein the text of the SMS message is included in the subject line of the MMS message (Paragraph 0006; 0044).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the suggested system of Kalfas and Szeto with the teachings of Rukman to convert a first message format into a second message format, wherein the text of the first message is included in the subject line of the second message. The motivation for the suggested modification is that Rukman's teachings would allow identification of the message in the subject header, and still allow the recipient to only check the content in the header in communication between different formats.

20. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalfas, in view of Whittle et al. US Publication #2005/0050462 (Whittle hereinafter).

21. As per claims 4 and 12, Kalfas teaches the method of claim 1, further comprising receiving the body-less electronic mail message over the network, displaying the body-less electronic mail message on a display screen as a line item in a mailbox view (Paragraph 0037. List of email messages.). Kalfas does not specifically teach of displaying on the display screen an entire contents of the subject line when a cursor is positioned over a subject column of the line item.

Whittle teaches of positioning a pointer over a text to cause the entire partition of the text to be displayed (abstract; paragraph 0023).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kalfas with the teachings of Whittle to implement a system wherein positioning a pointer over a text, such as text of a subject line, causes the entire portion of the text to be

Art Unit: 2154

displayed. The motivation for the suggested modification is that Whittle's teachings would allow users to efficiently view content and optimize the use of space on a window (Paragraph 0020; 0022).

23. Claims 5, 13, 20, 25, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalfas, in view of Lenoir, US Patent #7,231,082 (Lenoir hereinafter).

24. As per claims 5 and 13, Kalfas teaches the method of claim 1, further comprising receiving the body-less electronic mail message over the network, displaying the body-less electronic mail message on a display screen as a line item in a mailbox view having a column for the subject line (Paragraph 0037. Display listing of email messages). Kalfas does not specifically teach of displaying on the display screen a scroll bar arrow at one end of the subject line column, when a cursor is positioned over the subject column of the line item, for horizontally scrolling through the contents of the subject line.

Lenoir teaches of horizontal scroll bar at the end of a column for scrolling through the contents of the column (col. 11, lines 25-30. Pointer/cursors are inherent, and the horizontal scroll bar is displayed when a cursor is positioned on the column.).

25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kalfas with the teachings of Lenoir to implement a horizontal scroll bar at the end of a column for scrolling through the contents of the column. The motivation for the suggested modification is that Lenoir's teachings would allow a user to view the contents in a column, such as the subject, that is out of the viewing area.

26. As per claims 20, 25, and 30, Kalfas teaches the apparatus of claim 18, further comprising means for displaying the body-less electronic message as a line item in a mailbox view (Paragraph 0037. List of

Art Unit: 2154

email messages.). Kalfas does not specifically teach of horizontally scrolling through the sequence of one or more text messages while in the mailbox view.

Lenoir teaches of horizontal scroll bar at the end of a column for scrolling through the contents of the column (col. 11, lines 25-30).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kalfas with the teachings of Lenoir to implement a horizontal scroll bar for scrolling through the contents of the column in the mail box view. The motivation for the suggested modification is that Lenoir's teachings would allow a user to view the contents, such as the subject, that is out of the viewing area.

28. Claims 7-9, 14-17, 21-22, 26-27, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalfas, in view of Szeto.

29. As per claims 7, 14, 21, 26, and 31, Kalfas teaches the method of claim 1, further comprising converting the body-less electronic mail message to an online electronic chat conversation.

Szeto teaches of converting an e-mail message into instant message (Paragraphs 0041-0042).

30. It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the teachings of Kalfas with the teachings of Szeto to convert an email message such as the format of message in Kalfas into the instant message. The motivation for the suggested modification is that Szeto's teachings would allow instant messaging between an email user and instant messaging user (abstract).

31. As per claims 8, 15, 22, 27, and 32, Kalfas does not specifically teach the method of claim 1, further comprising converting a chat conversion into a body-less electronic mail message.

Szeto teaches of converting an instant message into an e-mail message (Paragraph 0036).

32. It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the teachings of Kalfas with the teachings of Szeto to convert an instant message into the email message such as the format of the message in Kalfas. The motivation for the suggested modification is that Szeto's teachings would allow instant messaging between an email user and instant messaging user (abstract).

33. As per claim 9, Kalfas does not specifically teach the method of claim 1, further comprising displaying on a user interface a chat-like graphical window for engaging in synchronous chat in response to receiving the body-less electronic mail message over the network.

Szeto teaches of engaging in instant messaging in response to receiving an email (Paragraphs 0036; 0043. Displaying a window such as an application is inherent to read and write messages. It is also inherent that instant messaging is done in real time.).

34. It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the teachings of Kalfas with the teachings of Szeto to engage in instant messaging in response to receiving an email. The motivation for the suggested modification is that Kalfas' teachings would allow instant messaging between an email user and instant messaging user (abstract).

35. As per claim 16, Kalfas does not specifically teach the computing system of claim 10, wherein the network interface communicates with the network over one of a wired and wireless connection.

Szeto teaches of network connection over a wired and/or wireless media (Paragraph 0045).

36. It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the teachings of Kalfas with the teachings of Szeto to implement network connection over a wired

Art Unit: 2154

and/or wireless media. The motivation for the suggested modification is that Kalfas' teachings would enhance the capability of Szeto's system by allowing communication over different types of media.

37. As per claim 17, Kalfas does not specifically the computing system of claim 10, wherein the computing system is one of a computer, a workstation, a personal digital assistance, a cellular telephone, and an online gaming platform.

Szeto teaches of the client device including a computer, pda, laptop, or a mobile phone (Paragraph 0045).

38. It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the teachings of Kalfas with the teachings of Szeto for the client device to include a computer, pda, laptop, or a mobile phone. The motivation for the suggested modification is that Kalfas' teachings would allow Kalfas' system to operate in different types of devices commonly owned by users, which would increase usability.

Conclusion

39. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2154

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


NATHAN FLYNN
SUPERVISORY PATENT EXAMINER

July 20, 2007
JJ